IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	**MAIL STOP AF**
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Christian M. Stich et al.)	Group Art Unit: 2192
)	
Application No.: 10/574,948)	Examiner: Marina Lee
)	
Filed: January 11, 2007)	Confirmation No.: 8426
)	
For: SYSTEM AND METHOD FOR)	
AUTOMATICALLY INSTALLING)	
VERIFYING AND CONFIGURING)	
FUNCTIONALITIES IN THE)	
SYSTEM COMPONENTS OF A)	
DISTRIBUTED NETWORK	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review and withdrawal of the final rejection dated March 16, 2011 because the Examiner committed clear error in rejecting claims 1-16 as follows:

1.   The Examiner Committed Clear Error in Rejecting Claims 1-5 and 11-13 Under 35 U.S.C. § 101, Because the Claimed System is Clearly Structural in Nature.

2.   The Examiner Committed Clear Error in Rejecting Claims 1-16 Under 35 § 35 U.S.C. §103(a), Because Neither Reference, Even When Considered in Combination, Discloses Applicants' Claim 1 System Planning Tool Comprising "the System Components for Automatically Checking and Configuring Specified Installation, Verification and/or Configuration Files in a Prescribed Order and Manner, Such That the System Components, When Configured, Form the System."

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1. The Examiner Committed Clear Error in Rejecting Claims 1-5 and 11-13 Under 35 U.S.C. § 101, Because the Claimed System is Clearly Structural in Nature

Claims 1-5 and 11-13 are rejected under 35 U.S.C. § 101 on the basis that the claimed invention is directed to non-statutory subject matter. The rejection is respectfully traversed.

Under 35 U.S.C. § 101, processes are patent-eligible subject matter. "The Supreme Court has articulated only three exceptions to the Patent Act's broad patent-eligibility principles: 'laws of nature, physical phenomena, and abstract ideas.'" *Research Corp. Technologies v. Microsoft Corp.*, No. 2010-1037, slip op. at p. 13 (Fed. Cir. Dec. 8, 2010), *citing Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). The Supreme Court has never clearly defined what constitutes an abstract idea. *Id.* at p. 14.

Following the Supreme Court's decision in *Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010), the Federal Circuit stated in the *Research Corp* case that "[I]nventions with specific applications or improvements to technologies in the marketplace are <u>not</u> likely to be so abstract that they override the statutory language and framework of the Patent Act." *Id.* at p. 15 (emphasis added).

Applicant's claims 1-5 and 11-13 constitute statutory subject matter. For example, claim 1 specifically recites a <u>system </u>for automatically installing, verifying and/or configuring functionalities stored in files for <u>components connected</u> in a distributed <u>network</u>. See, for example, claim 1, lines 1-4. Such a claimed system is structural in nature, and clearly has specific application and improvements to technologies. Claim 1 is <u>not</u> an abstract idea.

Accordingly, withdrawal of the written description rejection of these claims under 35 U.S.C. § 101 is required.

2.   The Examiner Committed Clear Error in Rejecting Claims 1-16 Under 35 § 35 U.S.C. §103(a), Because Neither Reference, Even When Considered in Combination, Discloses Applicants' Claim 1 System Planning Tool Comprising "the System Components for Automatically Checking and Configuring Specified Installation, Verification and/or Configuration Files in a Prescribed Order and Manner, Such That the System Components, When Configured, Form the System."

Claims 1-16 are also rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bourke-Dunphy et al. (U.S. Patent Application Publication No. 2002/0133814, hereinafter "Bourke-Dunphy") in view of Hellerstein et al. (U.S. Patent Application Publication No. 2002/0129356, hereinafter "Hellerstein").

The rejection is respectfully traversed at least because the cited references, even when considered in the combination asserted by the Examiner, fail to disclose or suggest Applicants' claim 1 system planning tool and comprises "the system components for automatically checking and configuring specified installation, verification and/or configuration files in a prescribed order and manner, such that the system components, when configured, form the system."

Referring Applicants' exemplary embodiment of Fig. 2, an automated system sets up a distributed network from empty computers to an installed, configured and operative network. Software packages which are dependent on one another are automatically distributed over the various system components, and the system components automatically checks and configure specified installation, verification and/or configuration files in a prescribed order and manner, such that the system components, when configured, form the system.

Applicants' claim 1 encompasses the foregoing features, as it a system planning tool comprising, *inter alia*, "the system components for automatically checking and configuring specified installation, verification and/or configuration files in a prescribed order and manner, such that the system components, when configured, form the system." Neither the Bourke-Dunphy nor the Hellerstein documents, considered individually or in combination, disclose such a feature.

Bourke-Dunphy discloses determining an installation procedure based on dependency requirements for components that are selected for installation. The installation procedure describes a desired order for installing selected application or service components. Paragraph 0079 of the Bourke-Dunphy document doesn't provide that the installation procedure defines a step-by-step process that <u>a user follows</u> to install the components and associated subcomponents.

Hellerstein discloses generating software packages that are candidates for installation in appropriate target machines. In the Hellerstein document, a base package preparer operation 502 receives as input information (e.g., the basic dependency information 506 indicating the pre-requisites), and constructs a base service package for each of the regions 512, 514 and 516. When a region server receives a base service package 522, it augments the base service package with specific dependency items that are needed by the individual machines within the region by a region package augmentor operation 520. The output is a set of customized packages 530 produced for each group of machines within the region.

According to the Bourke-Dunphy document, a user follows the installation procedure to install the components and associated subcomponents. See, for example, Bourke-Dunphy: paragraph 0079. <u>Bourke-Dunphy does not disclose that</u>

system components which automatically check and configure specified installation, verification and/or configuration files in a prescribed order and manner.

The Hellerstein document fails to overcome the deficiencies of the Bourke-Dunphy document. The Hellerstein document is concerned with generating software packages including a base service package, and customized packages. Hellerstein, however, fails to disclose or suggest system components that automatically check and configure specified installation, verification and/or configuration files in a prescribed order and manner as presently claimed.

Accordingly, Bourke-Dunphy and Hellerstein, whether considered individually or in combination, fail to disclose or suggest Applicants' claim 1 system planning tool comprising, "the system components for automatically checking and configuring specified installation, verification and/or configuration files in a prescribed order and manner, such that the system components, when configured, form the system."

At least for the reasons above, Applicants' claim 1 and the remaining pending claims are patentable.

Respectfully submitted,
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